

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** RAYMOND J. MIKELIONIS and DAVID CREGO

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Appeal No. 98-2123  
Application No. 08/326,669<sup>1</sup>

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ON BRIEF

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Before CALVERT, MEISTER and McQUADE, ***Administrative Patent Judges.***

MEISTER, ***Administrative Patent Judge.***

***DECISION ON APPEAL***

Raymond J. Mikelionis and David Crego (the appellants) appeal from the final rejection of claims 1-33, the only claims present in the application.

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<sup>1</sup> Application for patent filed October 18, 1994. According to appellants, this application is a continuation of Application No. 08/088,330 filed July 7, 1993, now abandoned.

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We AFFIRM-IN-PART.

The appellants' invention pertains to a wallet card having a sleeve adapted to removably receive an elongated function member such as a medical test strip or thermometer strip. Independent claims 1 and 32 are further illustrative of the appealed subject matter and copies thereof may be found in the APPENDIX to the brief.

The references relied on by the examiner are:

Cohan	3,792,542	Feb. 19,
1974		
Gee, Sr. (Gee)	3,958,690	May
25, 1976		
Palti	4,588,307	May 13,
1986		
Grover	4,619,469	Oct. 28,
1986		

The claims on appeal stand rejected in the following manner:

(1) Claims 1-4, 8-11, 13-16, 18-23 and 27-30 under 35 U.S.C. § 102(b) as being anticipated by Grover;

(2) Claims 1-4, 8-15, 17-22 and 27-32 under 35 U.S.C. § 102(b) as being anticipated by Gee;

(3) Claim 33 under 35 U.S.C. § 103(a) as being unpatentable over Cohan in view of Grover; and

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(4) Claims 5-7 and 24-26 under 35 U.S.C. § 103(a) as being unpatentable over Grover in view of Palti.

The rejections are explained on pages 3 and 4 of the answer. The arguments of the appellants and examiner in support of their respective positions may be found on pages 7-36 of the brief, pages 1-5 of the reply brief and pages 4-6 of the answer.

#### ***OPINION***

We have carefully reviewed the appellants' invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellants in the brief and reply brief, and by the examiner in the answer. As a consequence of this review, we will reverse Rejections (3) and (4). With respect to Rejection (1), we will sustain the rejection of claims 1-4, 8-11, 13-16, 18-22 and 27-30 and reverse the rejection of claim 23. With respect to Rejection (2), we will sustain the rejection of claims 1-3, 8, 9, 12-15, 18-22, 27, 28 and 31 and reverse the rejection of claims 4, 10, 11, 17, 29, 30 and 32.

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Before specifically considering the rejections based on anticipation (i.e., Rejections (1) and (2)), we initially note that the terminology in a pending application's claims is to be given its broadest reasonable interpretation (*In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997) and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)) and limitations from a pending application's specification will not be read into the claims (*Sjolund v. Musland*, 847 F.2d 1573, 1581-82, 6 USPQ2d 2020, 2027 (Fed. Cir. 1989)). Moreover, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. *See Verdegaa1 Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently (*Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997)); however, the law of anticipation does not require that the

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reference teach what the appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference (*see Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983)).

**Rejection (1):**

With respect to this rejection the appellants on page 6 of the brief state that (a) claims 1 and 2 stand or fall together as a first group, (b) claims 3, 4, 8 and 9 stand or fall together as a second group, (c) claims 13-15, 18-20, 22 and 27-29 stand or fall together as a third group and (d) claims 10, 11, 16, 21, 23, 30 and 32 each stand or fall alone. Accordingly, (a) claim 2 will stand or fall with representative claim 1, (b) claims 4, 8 and 9 will stand or fall with representative claim 3, (c) claims 14, 15, 18-20, 22 and 27-29 will stand or fall with representative claim 13 and (d) claims 10, 11, 16, 21, 23, 30 and 32 will each stand or fall alone. See 37 CFR § 1.192(c)(7).

Considering first the rejection of claims 1-4, 8-11, 13-16, 18-22 and 27-30, the examiner has taken the position that

in Grover a portion of pocket 51 forms an open-ended sleeve that is integrally bound in the card and is adapted to permit repeated receipt and withdrawal of an elongate functional member (i.e., spacer 55).

With respect to representative claim 1, the appellants argue that Grover does not have a sleeve that is adapted to permit repeated receipt and withdrawal of an elongate functional member. From the appellants' perspective, once the card of Grover is laminated, all the parts thereof are irreversibly heat-bonded together and thereafter no structure may be repeatedly received and withdrawn. In support of this position, the reply brief states that:

Grover's statement at column 5, lines 15-17 that: "[a]lternatively, the microfilm segment or segments 54 may be inserted into the pocket 51 through its mouth 52 after the front panel is positioned" should not be misconstrued to mean this occurs after his card is laminated together. Such microfilm placement is only suggested as an alternative method of assembly after the front panel is positioned atop the other elements, not after it is welded into place by the laminating process. [Page 3.]

We do not agree with the appellants' interpretation of the scope and content of Grover. Grover teaches a card 1 having a front panel 15, a back panel 16 and an inner core 2

positioned between the front and back panels having a cut-out 9 therein. Grover states that the elongated pocket 51 is formed in the cut-out 9 between the front and back panels, with the pocket being subdivided into discrete compartments 53. Grover forms these compartments by coating the inner surfaces of the front and back panels 15 and 16 with a heat sensitive adhesive 25, except in a plurality of area subparts 27 in the region of the pocket 51 (see col. 4, lines 27-34; Figs. 1 and 2). These subparts 27 serve to subdivide the pocket 51 into compartments 53 for the purpose of accommodating the microfilm segments 54 (see col. 4, line 63, through col. 5, line 33).

Microfilm segments 54 are initially placed in only *some* of these compartments and sealed therein by lamination of the front panel, back panel and core when the card components are placed in a laminating machine for a first time, leaving the remainder of the compartments both unsealed and empty (except for removable spacer 55 which, as more fully described, *infra*, prevents the empty compartments from being sealed during lamination - see, generally, cols. 5 and 6). Thus, after the

first placement of the card components in a laminating machine, those portions of (a) the top and bottom edges of the cut-out 9, (b) the inner surfaces of the front and back panels and (c) the outermost portion of the sealed compartment which are adjacent the empty compartments form a sleeve that is "integrally bound therein" as broadly set forth in independent claim 1.

As the appellants have noted, spacer 55 may also be used to insert the microfilm segments into the compartments 53 before there is any lamination of the panels and core (see col. 5, lines 15-17). However, Grover goes on to state that the spacer 55 is inserted into the pocket and is

positioned so that its end 56 is located slightly outwardly (toward the core side edge 8) of the most outward adhesive line 28 whereat the front and back panels 15 and 16 are to be thermally laminated together. For example, if two microfilm segments 54 are to be thermally sealed within respective compartments 53, the spacer end 56 is placed just outwardly of the second adhesive line 28 from the core blind end 10.

The core 2, panels 15 and 16, microfilm segments 54 and spacer 55 are then subjected to heat and pressure in a conventional plastic laminating machine (not shown). The heat sensitive adhesive 25 thereby thermally laminates or bonds the front panel 15 to the core front surface 3, the back panel 16 to



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the back surface **4** and the front and back panels **15** and **16** together at the adhesive lines **28 not separated by the spacer 55**. [Col. 5, lines 40-56; emphasis added.]

Thereafter, Grover states that:

Microfilm segments **54 may be added subsequent to the initial forming of the card 1** by inserting them within the pocket **51** into position between the **remaining** subparts **27** of the panels **15** and **16** which have not been sealed into the compartments **53**. The spacer **55** is **then inserted** into any **remaining** compartments **53**, and the card **1** placed in a laminating machine whereby the **last** enclosed microfilm segments **54** are sealed within the respective compartments **53**. [Col. 6, lines 42-50; emphasis added.]

In view of the above, it is readily apparent that, **subsequent** to the first placement of the card components of Grover in a laminating machine, the spacer 55 is both removable from and insertable into those compartments 53 (and hence the sleeve) that are unsealed and empty for the purpose of placing additional microfilm segments into these empty compartments. This being the case, the spacer 55 (i.e., a functional member) has the **capability** of repeated receipt and withdrawal as set forth in representative claim 1.

With respect to representative claim 3, the appellants argue that the spacer 55 of Grover is not a test strip. While

this may be true, the recitation of the sleeve "being adapted to permit" repeated receipt and withdrawal of a test strip does not require that a test strip actually be received and withdrawn from the sleeve. Instead, this recitation merely sets forth a function which the sleeve must be structurally capable of performing (**see, e.g., *In re Venezia***, 530 F.2d 956, 959, 189 USPQ 149, 151-52 (CCPA 1976)) and whether a test strip actually is or might be inserted into the sleeve of Grover depends upon the performance or non-performance of a future act of use rather than a structural limitation in the claim. Since the spacer 55 of Grove has the capability of repeated receipt into and withdrawal from the sleeve, there is a sound basis to conclude that Grove's sleeve likewise has the capability of repeated receipt and withdrawal of a test strip. It is well settled that if a prior art device inherently possesses the capability of functioning in the manner claimed, anticipation exists regardless of whether there was a recognition that it could be used to perform the claimed function. **See, e.g., *In re Schreiber***, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). See also ***In re Spada***,

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911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990): "The discovery of a new property or use of a previously known composition, even when that property and use are unobvious from prior art, can not impart patentability to claims to the known composition."

With respect to representative claim 10 the appellants argue that Grover's front panel 15 cannot be considered to have a display window because it is covered by an opaque layer 41. This argument is not commensurate with the scope of the claimed subject matter since there is no requirement in representative claim 10 that the "front panel" have a display window. Instead, this claim more broadly requires that the "card" have such a display window. In Grover, both the front panel 15 and back panel 16 are transparent (see col. 4, lines 20 and 21). Thus, even though Grover's front panel 15 may be covered by an opaque security cover 41, the back panel 16 is not. Accordingly, the compartments 53 of Grover's card can be considered to form a transparent display window as claimed (albeit only visible in the back panel 16).

With respect to claim 13, the appellants argue that in Grover any sleeve must be formed from something that is a part

of the front and back panels whereas the claims make it clear that sleeve is a separate element. We must point out, however, that representative claim 13 only broadly recites a front **surface** and a back **surface** (i.e., the front and back boundaries<sup>2</sup> or "skin" of the card) and a sleeve. Accordingly, the outermost boundary or "skin" of the panels 15 and 16 of Grover can be considered to satisfy the limitation of front and back surfaces whereas the innermost surfaces of these panels can be considered to form a part of the sleeve in the manner that we have discussed in detail above with respect to representative claim 1.

With respect to claims 16 and 30 the appellants argue that Grover does not show a core panel that is separate and apart from the sleeve. We disagree. As we have noted above, the sleeve is formed by those portions of the core, panels and the endmost compartment containing a laminated microfilm segment 54 which define the empty compartments, whereas the compartments having the microfilm laminated therein can be

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<sup>2</sup> ***The American Heritage Dictionary, Second College Edition***, 1982, Houghton Mifflin Company, Boston, MA, defines "surface" as --1.a. The outer or topmost boundary of an object--.

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considered to be a cutout "having personal medical information-bearing microfilm mounted therein" as set forth in this claim.

As to claim 21, the appellants contend that any sleeve which Grover might have is adjacent the lower edge of the card, rather than the top edge as claimed. We must point out that the particular orientation of the card (i.e., whether it is turned with a particular edge up or down) does not serve to structurally distinguish the claimed card over that of Grover. ***See, e.g., LaBounty Mfg. v. Int'l Trade Comm'n***, 958 F.2d 1066, 1075, 22 USPQ2d 1025, 1032 (Fed. Cir. 1992).

In view of the foregoing, we will sustain the rejection of claims 1-4, 8-11, 13-16, 18-22 and 27-30 under 35 U.S.C. § 102(b) as being anticipated by Grover.

Turning to the rejection of claim 23 under 35 U.S.C. § 102(b) as being anticipated by Grover, this claim expressly requires a test strip to be stowed within the sleeve. There is no teaching in Grover of a test strip, much less a test strip stowed within the sleeve. This being the case, we will not sustain the rejection of claim 23 under 35 U.S.C. § 102(b) based on the teachings of Grover.

**Rejection (2):**

With respect to this rejection, the appellants on page 6 of the brief state that (a) claims 1 and 2 stand or fall together as a first group, (b) claims 3, 8 and 9 stand or fall together as a second group, (c) claims 10 and 11 stand or fall together as a third group, (d) claims 13-15 and 18-22 stand or fall together as a fourth group, (e) claims 29 and 30 stand or fall together as a fifth group and (f) claims 4, 12, 17 and 32 each stands or falls alone. Accordingly, (a) claim 2 will stand or fall with representative claim 1, (b) claims 8 and 9 will stand or fall with representative claim 3, (c) claim 11 will stand or fall with representative claim 10, (d) claims 14, 15 and 18-22 will stand or fall with representative claim 13, (e) claim 30 will stand or fall with representative claim 29 and (f) claims 4, 12, 17 and 32 will each stand or fall alone. See 37 CFR § 1.192(c)(7). Although not grouped by the appellants, claims 27, 28 and 31 have not been separately argued with any reasonable degree of specificity. Accordingly, these claims will stand or fall with representative claim 13. See 37 CFR § 1.192(c)(7) and **In re**

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**Nielson**, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987).

Treating first the rejection of claims 1-3, 8, 9, 12-15, 18-22, 27, 28 and 31, the answer states that in Gee the sleeve 14 has open edges and is

capable of receiving a functional member therein, for example, medication tablet 38, sugar bag 26, etc. The claimed limitations of a "test strip" and a "medical test strip" (claims 4-5, etc.) are met by the sugar bag and medication tablet package, respectively. Regarding the "window" arguments, note that claim 10 recited "wherein said card further includes a transparent display window therein". The card 10 of Gee is made of transparent, "see through" feature, (column 2, lines 60-64). Therefore, the top or bottom surfaces of the card 10 is considered as the display window. Insofar as the record is concerned, the Examiner did not state that to stow a thermometer in the sleeve is well known in the art. However, the sleeve 14 of Gee does have an open end for receiving a variety of functional members therein, such as sugar bag or medication package. Thus, Gee's sleeve clearly has the capacity of receiving a variety of things as of Appellants' sleeve such as a microfilm as taught by Cohan or a thermometer strip, needles or toothpick. Appellant argues that the prior art does not provide a "cutout" portion. The "cutout" (claim 16) limitations are met by the cutout 24 of Gee and the microfilm can be located therein instead of the sugar bag 26. [Pages 5 and 6.]

The appellants argue that the member 14 of Gee cannot be considered to be a sleeve "integrally bound therein"

(representative claim 1) or "integrally bound between said front surface and said back surface" (representative claim 13). With respect to claim 12, the appellants additionally argue that Gee does not teach a sleeve which comprises a folded rectangular length of stock bound between a front layer and a back layer of the card. We disagree with these contentions. Gee's sleeve 14 (styled by Gee as a card) is formed much in the same manner as the appellants' sleeve 24 (i.e., it is formed by folding a rectangular length of stock in half) and when this sleeve is inserted into the envelope or jacket 10 it can be considered to be "integrally bound therein" as broadly claimed. Although the appellants argue that Gee's sleeve is not "bound" therein since it is removable, the broad recitation of "bound" does not preclude removability. The sleeve 14 of Gee receives an elongate member 22 which has the capability of being repeatedly received and withdrawn from the sleeve. While the examiner has noted that the envelope or jacket 10 of Gee may be transparent (see col. 2, line 64), we also observe that in the embodiment of Fig. 7 this jacket or envelope may be "paper or cardboard" (see col. 3, line 60) and, thus, the envelope or



jacket 10 in conjunction with the sleeve 14 can be considered to comprise the card. As the examiner has noted, Gee's sleeve 14 has an elongate functional member 22 stowed therein in such a manner so as to be capable of repeated withdrawal from and receipt into the sleeve.

With respect to representative claim 3, the appellants argue that Gee does not include a test strip. However, as we noted above in Rejection (1), the recitation "being adapted to permit" repeated receipt and withdrawal of a test strip does not require that a test strip actually be received into and withdrawn from the card but, instead, merely sets forth a function which the card must be structurally capable of performing (**see, e.g., *In re Venezia, supra***). The sleeve 14 of Gee clearly has the capability of receiving a test strip and whether a test strip actually is or might be inserted into the sleeve of Gee depends upon the performance or non-performance of a future act of use rather than a structural limitation in representative claim 13. As we have also noted above in Rejection (1), it is well settled that if a prior art device inherently possesses the capability of functioning in the manner claimed, anticipation exists regardless of whether

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there was a recognition that it could be used to perform the claimed function. ***See In re Schreiber, supra,*** and ***In re Spada, supra.***

In view of the above, we will sustain the rejection of claims 1-3, 8, 9, 12-15, 18-22, 27, 28 and 31 under 35 U.S.C. § 102(b) as being anticipated by Gee.

We now turn to the rejection of claims 4, 10, 11, 17, 29, 30 and 32 under 35 U.S.C. § 102(b) as being anticipated by Gee. With respect to claim 4, the examiner is of the opinion that the medication tablet 38 and sugar bag 26 of Gee can be considered to be a test strip. In our view, however, the examiner is attempting to unduly expand the meaning of "test strip." Consistent with the appellants' specification, we do not believe that one of ordinary skill in this art would construe either medication tablets or a sugar bag to correspond to the claimed test strip. With respect to claims 10, 11, 29 and 30, the examiner apparently is of the opinion that transparent jacket or envelope 10 can be considered to be a "window therein" as set forth in claim 10 and 29. However, the transparent jacket or envelope 10 forms the entire outer

surface of Gee's card and, from our perspective, cannot fairly be construed as a "window therein" as set forth. Claim 17, by virtue of its dependency on claim 13, requires, *inter alia*, a card having (1) a front surface, (2) a back surface, (3) a core panel comprised of front and back sheets and (4) a sleeve bound integrally between the front and back surfaces which is comprised of a folded rectangular length of material bound between the front and back sheets (of the core panel). While the sleeve 14 of Gee bound integrally between the front and back surfaces of the card, it is not also bound between the sheets of a core panel. Claim 32 requires, *inter alia*, a card having (1) opposed front and back surfaces, (2) a core panel between front and back surfaces comprised of a single sheet that is folded to define front and back sheets and (3) an elongate rectangular length of stock bisected by a fold so as to form a sleeve that is nested inside the fold of the core stock. As we have noted above with respect to claim 17, the sleeve 14 of Gee is not bound or nested against the inside of the fold of a core panel. In view of the above-noted deficiencies of Gee, we will not sustain the rejection of

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claims 4, 10, 11, 17, 29, 30 and 32 under 35 U.S.C. § 102(b)  
based on this reference.

**Rejection (3):**

According to the examiner:

Cohan discloses all the limitations of the claims except for an integrally bound sleeve with the card. Grover discloses an integrally bound sleeve that may be used to store an elongate functional member. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cohan to include an integrally bound sleeve similar to Grover that would allow the card to store rectangular members such as medical test strips. [Answer, page 3.]

We will not support the examiner's position since, even if the references were combined in the manner proposed by the examiner, the claimed invention would not result. That is, claim 32 expressly requires a thermometer strip to be stowed within the sleeve; however, neither Cohan nor Grover either teaches or suggests a thermometer strip stowed within a sleeve. This being the case, we will not sustain the rejection of claims 33 under 35 U.S.C. § 103(a) based on the combined teachings of Cohan and Grover.

**Rejection (4):**

The examiner considers that it would have been obvious to stow a thermometer strip in the sleeve of Grover in view of the teachings of Palti. As we have noted above in Rejection (1), a backing member 55 is stowed in the sleeve of Grover in order to prevent empty compartments from becoming sealed during subsequent lamination. Palti discloses a dispenser for thermometer strips contained in package. Absent the appellants' own disclosure we are at a total loss to understand why one of ordinary skill in this art would have been motivated to single out the provision of a thermometer strip from Palti's disparate teachings and incorporate it into the card of Grover in the manner proposed by the examiner. Accordingly, we will not sustain the rejection of claims 5-7 and 24-26 under 35 U.S.C. § 103(a) based on the combined teachings of Grover and Palti.

In summary:

The rejection of claims 1-4, 8-11, 13-16, 18-22 and 27-30 under 35 U.S.C. § 102(b) as being anticipated by Grover is affirmed.

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The rejection of claim 23 under 35 U.S.C. § 102(b) as being anticipated by Grover is reversed.

The rejection of claims 1-3, 8, 9, 12-15, 18-22, 27, 28 and 31 under 35 U.S.C. § 102(b) as being anticipated by Gee is affirmed.

The rejection of claims 4, 10, 11, 17, 29, 30 and 32 under 35 U.S.C. § 102(b) as being anticipated by Gee is reversed.

The rejection of claim 33 under 35 U.S.C. § 103(a) as being unpatentable over Cohan in view of Grover is reversed.

The rejection of claims 5-7 and 24-26 under 35 U.S.C. § 103(a) as being unpatentable over Grover in view of Palti is reversed.

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No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

***AFFIRMED-IN-PART***

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JAMES M. MEISTER	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
JOHN P. McQUADE	)	
Administrative Patent Judge	)	

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